

REMARKS

Introduction

Claims 1 – 7 were originally pending in this application. Claim 1 has been amended. No new matter has been added. Thus, claims 1 – 7 remain in this application.

Drawings

The drawings were objected to because they do not include reference numeral 50 as described on page 14, line 20 and reference numeral 94 as described on page 17, line 15. Accordingly, replacement Figures 6 and 7 are submitted herewith. Replacement Figure 6 has been amended to designate the transmission as 50, instead of 52 and replacement Figure 7 has been amended to label the carrier with reference numeral 94. Attorney for applicants apologizes for these errors.

The Specification

The disclosure was objected to because the pawls 24 were incorrectly described as “engagement members” at page 11, paragraph [0027]. Paragraph [0027] has been amended to correct this discrepancy and to make this paragraph consistent with the rest of the specification. Duplicate paragraph [0028] has been deleted.

In addition, line 4 of paragraph [0036] on page 16 has been amended to properly designate the underdrive clutch with reference numeral 54. Attorney for applicants apologizes for these typographical errors.

Claim Rejections

35 U.S.C. § 112

Claims 1 – 7 were rejected under 35 U.S.C. § 112, ¶2, as being indefinite. More specifically, the Examiner pointed out that the expression, “said inner race of said friction clutch” in line 13 of claim 1 lacked sufficient antecedent basis. Accordingly, claim 1 has been amended to refer to the inner *hub* of said friction clutch. Antecedent basis for this expression can be found at line 9 of claim 1.

35 U.S.C. § 103

Claims 1 – 7 were rejected under 35 U.S.C. § 103(a) as being obvious over the Koenig ‘531 patent in view of the Stefina ‘200 patent. However, the Examiner also noted that this rejection might be overcome by showing that the references are disqualified under 35 U.S.C. § 103(c) as prior art in a rejection under 35 U.S.C. § 103(a). MPEP § 706.02(l)(1) and § 706.02(l)(2).

Statement of Common Ownership

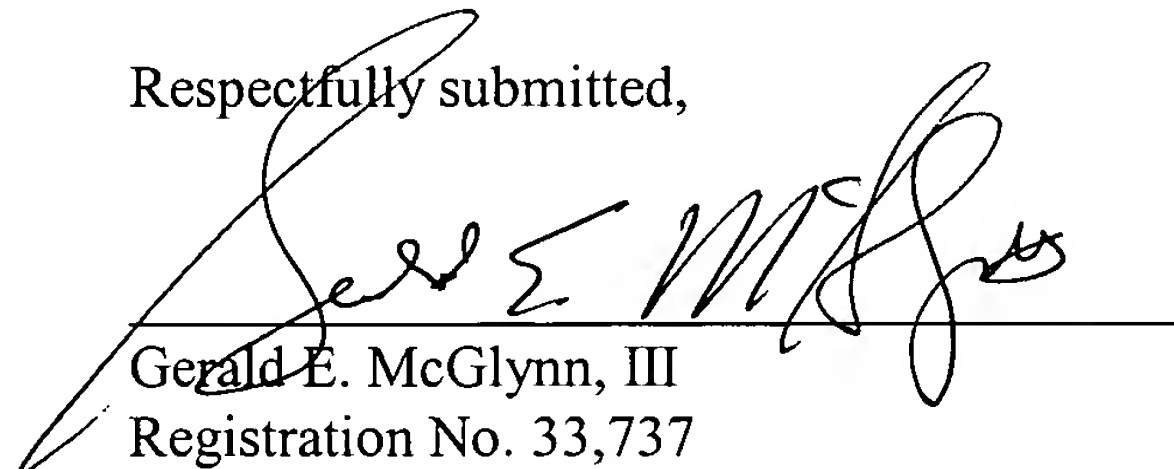
U.S. Patent No. 6,830,531 issued to Koenig et al. is assigned to BorgWarner Inc. This assignment has been recorded on April 22, 2004 at Reel 015243, Frame 0707 and is attached hereto. Thus, BorgWarner Inc. owns 100% of the ‘531 patent. U.S. Patent No. 6,814,200 is similarly assigned to BorgWarner, Inc. This assignment has been recorded on March 18, 2003 at Reel 013866, Frame 0700 and is attached hereto. Thus, BorgWarner Inc. owns 100% of the ‘200 patent. Likewise, the present application having U.S. Serial No. 10/627,845 has been assigned to BorgWarner Inc. This assignment has been recorded on March 30, 2006 at Reel 017387, Frame 0218 and is attached hereto. Thus, BorgWarner Inc. owns 100% of the ‘845 application. Moreover

the present application having U.S. Serial No. 10/627,845 and both of the Koenig '531 and Stefina '200 patents were, at the time the invention of the application having U.S. Serial No. 10/627,845 was made, 100% owned by BorgWarner Inc. See MPEP 706.02(1)(2)II. Accordingly, applicants, through their undersigned attorney, respectfully submit that both the Koenig et al. '531 and Stefina '200 patents are disqualified as prior art to the present application under 35 U.S.C. § 103(c). For these reasons, applicants respectfully request that the rejection under the Koenig et al. and Stefina references be withdrawn.

Conclusion

In view of the above, it is respectfully submitted that claims 1 - 7, as amended, are patentably distinguishable over the prior art of record. Accordingly, the applicants respectfully solicit the allowance of claims 1 - 7 presently pending in this case.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Gerald E. McGlynn, III", is written over a horizontal line.

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